IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rahul SRIVASTAVA	Art Unit: 2175
Appl. No.: 10/711,791	Examiner: Campbell, Joshua D.
Date Filed: 10/05/2004	Atty. Docket No.: ORCL-006/OID-2004-061-01
For: Reducing Programming Complexity in Applications Interfacing With Parsers for Data elements Represented According to a Markup Languages	

Reply Brief Under 37 CFR § 41.41

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Commissioner for Patents
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Sir:

Applicants submit this reply brief under 37 CFR § 41.41 following the Examiner's Answer (hereafter `eadated 04/29/2009.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No.: 20-0674.

With respect to rejections under 35 USC § 101, in page 7 lines 7-15 of the Examiner's Answer, Appellants respectfully request the Patent Office to adapt the test laid out in *In re Bilski, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008).*

The Examiner appears to allege that a system existing as pieces of software is *per se* not patent eligible. Appellants respectfully disagree and contend that such a broad position is not supported by the holdings of *Bilski*.

As held in *Bilski*, an invention is patent eligible if it passes either a specific machine or transformation test. The subject matter here clearly satisfies the 'specific machine' test in providing an event based parser, which can be analogized to raw material (or tool) that can be used by various applications.

In page 11 lines 7-20 of the Examiner's Answer, the Examiner asserts that, "…The **XML file itself must contain data elements prior to being received** otherwise there would be absolutely no information for the system to process, and thus no functionality." (**Emphasis Added**)

In response, Appellants point the Boards attention to the Abstract of Nielsen, which clearly states that, "A method for dynamically modifying a mark up language document (e.g., an XML test suite file) during runtime with **data unavailable when the mark up language document is created**. A mechanism is also provided for allowing one to specify a location in the mark up language document for inserting the data." (Abstract of Nielsen, **Emphasis Added**).

Indeed a portion of Nielsen relied upon by the Examiner further discloses, "[0069] A walk through of the processing performed by the present invention is now described. First, the test suite document is parsed into a DOM, which is a standard way to programmatically represent XML documents internal to a program. As described previously, the mechanisms of the present invention modify the internal representation of the document. Similarly, the modifications, replacements, and insertions in the exemplary test document illustrated in **FIGS. 5-9 represent changes and modifications**

to the internal representation of the document and not to the document itself. It is noted that **the test document is not modified by the mechanisms of the present invention**."

From the above teachings, it is clear that the data elements relied upon by the Examiner, and for which the XPath is determined, **are not retrieved from the XML file** (contrary to what is required by the independent claims). As the Examiner appears to have misinterpreted the disclosure of Nielsen, Appellants respectfully request reversal of the rejections under 35 U.S.C. § 103.

However, for the benefit of the Honorable Board as well as the Examiner, Applicants further summarize the operation of Nielsen into 3 separate phases:

A. When the XML document is read into a memory representation (DOM);

B. Operation of injection mechanism; and

C. Continuation of execution of test script (test interaction)

With respect to A, there is no provision of the portion identifier and the associated data element. The XPath of Figure 5 of Nielsen in tag <ref:key> would simply be a data element provided for loading into the DOM. Assuming this XPath is analogized to the claimed portion identifier, there is no associated data element being provided.

With respect to B, the injection mechanism replaces the XPath elements in the memory representation with corresponding values, which are dynamically determined (due to the very problem Nielsen seeks to address). The value that replaces the XPath is not part of the XML document, as illustrated by correlating Figures 5 (test file) and 6.

With respect to C, paragraphs 73, 74, 90 and 91 of Nielsen indicates that only the data elements are sent for test interaction.

Therefore, in all the 3 phases noted above, the claimed feature of providing portion identifier in association with the corresponding data element is not present.

In page 7 lines 14 to page 8 line 5 of the Examiner's Answer, it was stated -- In response to appellant's arguments, the recitation "...said method being implemented in a parser..." has not been given patentable weight because the recitation occurs in the preamble. **A preamble is generally not accorded any patentable weight** where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). -- (**Emphasis Added**)

It is respectfully noted that the term 'parser' is recited in the body of independent claims 1 and must be accorded patentable weight. The mere recitation of the parser in preamble does not preclude patentable weight to a term recited in the body of the claim.

In page 8 lines 5-16 of the Examiner's Answer, the Examiner asserts, "Cseri teaches that **providing in association the portion identifier and the first data element** to an external application is performed by the parser (Figures 2, 3A, and 3B of Cseri)." (**Emphasis Added**).

Appellants first point to the absence of specificity on which particular elements/teachings of Cseri have the alleged teachings.

Irrespective, Appellants assert that no parser of Cseri provides to an application the portion identifier and the data element in association, as claimed. In this regard, the Board's attention is directed to the absence of application in the three Figures 2, 3A and 3B, relied upon by the Examiner. It is nevertheless noted that the three Figures merely show the transmission of an XML document from a transmitting device 200 to a receiving device 300 (containing XML parser(s)). Though a bi-directional bus is shown between the two devices, it is believed that receiving device does not send back XML data to transmitting device.

With respect to the receiving device, Cseri discloses, "[0062] … Then, at the receiving computing device 300, a piece of code 310, the parser, **parses the XML formatted document for an application**, such as a Web browser, although it may be parsed for use by any application, process, device, etc." (**Emphasis Added**). Thus, the receiving device 300 is described as parsing the XML formatted document for an application.

What is provided to the application in Cseri is further described with respect to Figure 4B of Cseri. As shown there, both parsers 310a and 310, provide "Parsed XML DATA". See Paragraph 67 of Cseri for further details of Figure 4B. There is no teaching or reasonable suggestion that the portion identifier and the data element are provided in association to the application, in Cseri.

From the above, it is concluded that the Examiner's rejection is based on misinterpretation of Cseri. Reversal of the rejections under 35 U.S.C. § 103 is again respectfully requested.

The above conclusion is also relevant to the Examiner's allegation in page 9 lines 2-5 of the Examiner's Answer.

In Page 10 line 17 to page 11 line 6, it is stated, "The Cseri reference not only teaches the use of a SAX parser (event based parser), but also teaches that in XML technologies it is notoriously well-known to use both event based parsers and tree-based parsers (DOM parsers) (page 3, paragraphs 0028-0029 of Cseri). Cseri discloses that the technologies of DOM, SAX, XPath, and XPointers are all notoriously well-known ways of implementing XML applications (page 3, paragraph 0029 of Cseri). Thus, the technologies presented are clearly notoriously well-known in the art and by **definition interchangeable by one of ordinary skill in the art at the time the invention was made**. For these reasons, the rejection is clearly proper and must be maintained."

Appellants respectfully note that replacing the DOM parser of Nielsen with a SAX parser would require at least a substantial amount of reengineering for several

reasons. For example, the SAX parser would generally not create the same internal memory representation (134 of Figure 1 of Nielsen) as the DOM parser used there. Without such a memory representation, the fundamental operation of Nielsen would need to be changed substantially (for example, because the injection mechanism relies on such a representation), at the minimum.

Thus, interchanging the DOM with SAX parser in Nielsen would not be obvious to one skilled in the relevant arts.

Irrespective, it is noted neither DOM nor SAX operation would provide the portion identifier and data element in association, as required by the independent claims.

The Office is invited to telephone the undersigned representative at 707.356.4172 if it is believed that an interview might be useful for any reason.

Respectfully submitted,
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